

species of the claimed invention,” and calls for the election of a single one of the alleged species for prosecution on the merits.

2. *The Restriction Requirement.* According to the Office Action, the claims are directed to the following allegedly distinct species of the invention:

SUBSTRATE WITH FIRST LAYER

Species I: Claims 20, 28, 33, and 41

Species II: Claims 21, 27, 34, and 40

SECOND LAYER

Species A: Claims 23 and 36

Species B: Claims 24 and 37

Species C: Claims 25 and 38

RECEIVED

AUG 20 2002

TECHNOLOGY CENTER R3700

Further, the Office Action identifies claims 18, 19, 22, 26, 29-32, 35, 39, and 42-46 as being generic.

As a preliminary observation, the Assignee has some measure of doubt as to the propriety of the restriction requirement imposed by the Office Action. Under the applicable statutes and regulations, restriction requirements are proper only in instances where “two or more *independent and distinct* inventions are claimed in a single application.” 37 C.F.R. § 1.142 (emphasis added). It is not at all clear to Assignee that this threshold criteria is met by the claims at issue.

As to the *independence* requirement, it must be shown that the alleged species are “unconnected in design, operation, or effect.” M.P.E.P. 802.01. As between the primary groupings of claims (Species I and II), the only distinction to be drawn is whether the substrate upon which the socket assembly is formed comprises a ceramic or organic material, on the one hand, or a die/package of another socket assembly upon which a subsequent socket assembly is formed, on the other hand. *See*, Specification, at page 6, lines 1-3. Inasmuch as the Specification

explicitly acknowledges that practicing the invention can involve forming a first socket assembly on a ceramic or organic substrate and subsequently forming a second socket assembly on the die/package of the first socket assembly, it is not at all clear that the allegedly distinct species are, in fact, “unconnected in design, operation, or effect.” *Id.*

As to the secondary grouping of claims (Species A, B, and C), the only distinction to be drawn is whether the “second material” (zirconium tungstate) is of the single-crystal, amorphous, or polymer-bound variety. Once again, Assignee is dubious that such marginal variation constitutes unconnectedness in design, operation, or effect.

Regarding the *distinctness* requirement, it must be shown that the claimed inventions “are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.” M.P.E.P. § 802.01 (emphasis in original). Assignee is highly dubious that this requirement is met with respect to either the primary grouping (Species I and II) or secondary grouping (Species A, B, and C).

The claimed invention relates to formation, on a substrate, of a two-layer socket assembly comprising two materials of differing coefficients of thermal expansion. As noted above, the Specification notes that the substrate may be either a ceramic or organic material, or the die/package of another socket assembly. In imposing the restriction requirement, the Office Action is implicitly asserting that formation of the disclosed two-layer socket assembly on a ceramic or organic material is an invention patentably distinct from formation of the disclosed two-layer socket assembly on a die/package of a first socket assembly. Applying reasonable criteria of non-obviousness, the Assignee has doubts as to the Office Action’s implicit assertion.

Nevertheless, in the interests of advancing the subject application to issuance, the Assignee elects to prosecute the invention of Species II (claims 21, 27, 34, and 40) and Species A (claims 23, and 36). Pursuant to M.P.E.P. 809.02(a), Assignee is required to provide a listing of all claims readable on the elected species; this list is as follows:

18-19, 21, 22, 26, 27, 29-32, 34-36, 39, 40, and 42-46.

CONCLUSION

It is believed that each of the claims pending in the application allowable, and that the application as a whole is in proper form and condition for allowance. Examination and allowance is therefore respectfully requested, such that the application may advance to issuance at the earliest possible date. If the Examiner believes that the application can be placed in even better condition for allowance, s/he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: 9-AUG-2002

Hugh R. Kress

Hugh R. Kress  
Reg. No. 36,574  
WINSTEAD SECHREST & MINICK, P.C.  
2400 Bank One Center  
910 Travis Street  
Houston, Texas 77002  
(713) 650-2714(voice)  
(713) 650-2400 (fax)

ATTORNEY FOR ASSIGNEE

HOUSTON\_1\590446\1  
23804-P002C1 08/09/2002